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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,379	09/20/2000	David V. Clayton	T9163	6140
7590	04/22/2004		EXAMINER	
Michael W Starkweather Thorpe North & Western LLP PO Box 1219 Sandy, UT 84091-1219			BOCCIO, VINCENT F	
			ART UNIT	PAPER NUMBER
			2615	
DATE MAILED: 04/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/666,379	CLAYTON, DAVID V.
	Examiner	Art Unit
	Vincent F. Boccio	2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 20 September 2002.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 2.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**  
**Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Butler et al. (GB 2327837 A).

Regarding claims 1-4, 7, 14 and 16, Butler discloses and meets the limitations associated with

- a digital storage medium (page 18, "movie ... on a DVD");
- a movie mask file (page 14, "image mask ... HTML ... overlaid on top of the video"), that stores both location masking data and masking data ("downloaded from an internet source");
- a display device (Fig. 1, "computer with display 14");
- a computing device (computer 14) coupled to the display device, having

1) a player system that operates to combine the digital data and the A/V masking data (abstract, hyperlink overlay on the video stream), before being displayed on the display device (met by an overlay processor accomplished prior to the displaying on the computer with display 14 with the DVD media, having a corresponding drive, being a DVD player); and

2) a library that holds the A/V masking data before being used by the player system (page 18, "broadcast overlay files during the night to user equipment, for use the following day", therefore, stored prior to usage, such as the night before, being downloaded therefore, meets the limitation of a library).

Regarding claims 5-6, Butler further meets the limitations of wherein if the masking/overlays matches the digital data before being combined in the system (met by page 17, "the control data indicates times at which the data files should be rendered or made visible", page 16, ""overlays are displayed at the times indicated by the timing specification contained in the control data), wherein since dictated the mask/overlay content

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is not random, or wherein the step of playing the digital data without the A/V masking data if there is no corresponding A/V mask or the A/V masking data does not match.

Regarding claim 18, Butler shows a computer system 14, which the system or player or display system, comprises a software program for facilitating the overlaying/masking of HTML, content over video from a DVD for example (pages 8-, computer system with Windows software).

Claims 14-17 and 19-20 are analyzed and discussed with respect to the anticipated claim limitations, with respect to Butler.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (GB 2327837 A).

Regarding claims 8-13, Butler mentions MPEG 2 for the video and wherein the video and ancillary can be carried by an MPEG 2 stream, but, fails to mention, when going to the next displayable frame of digital data and decompressing associated data therefrom, interpreted as compression overlay from the source.

The examiner takes official notice that compression of information is well known takes many forms, depending on the information which provides advantages of decreasing the size of files, thereby increasing the speed of delivery by having less information, requiring less storage space, as is well known, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Butler by incorporating comprising going the next frame {decompression of MPEG 2 video frame from the DVD}, and decompressing associated data {masking/overlay}, wherein the decompressed masking/overlay data would be rendered or overlay-ed onto the

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decompressed video frame/frames {duration}, as is obvious to those skilled in the art, wherein masking/overlay, or in other words the system determines whether there are modifications needed for the next frame by reading the location making data or timing information in the library of masking file (page 15, "indicating times for displaying the hyperlink overlays in relation to the video stream", page 15-16, "files are sent prior to the time that they are needed"), wherein upon reproduction, the system would access the files/library for all masking data for frame/frames, as dictated by the overlay files, during reproduction of the DVD, wherein, wherein according to Fig. 1, the system or computer, provides for outputting masked video to the display unit, wherein the system or the player provides for combining masking and digital data at the system or player, met by the computer system or player or display system, wherein the system determines based on the file data the next even successive frame overlay processing for all video, next frame to last frame specified upon the ending frame, the DVD will end reproduction, as is conventional.

**Contact Fax Information**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

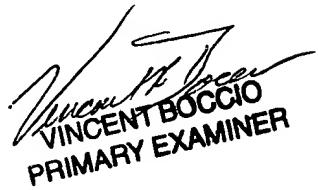
**Contact Information**

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
4/19/04



VINCENT F. BOCCIO  
PRIMARY EXAMINER